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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/623,852    03/26/96    HARD

R    023852

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IMS170506

EXAMINER

BOS.11

ART UNIT

PAPER NUMBER

1754

DATE MAILED:

05/06/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/623,852**

Applicant(s)  
**Hard et al**

Examiner  
**Steven Bos**

Group Art Unit  
**1754**



☒ Responsive to communication(s) filed on Feb 26, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

A suggested title is: A PROCESS FOR RECOVERING METAL VALUES BY DISSOLVING THEM IN A SULFURIC ACID SOLUTION CONTAINING CARBON AND A REDUCING AGENT OTHER THAN CARBON.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, "to render a metal value insoluble" and "being recovered and render the one or more additional metal values insoluble" are new matter.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, "being recovered and one or more additional metal values" is awkward and confusing as to exactly what is being claimed.

Also, "to render a metal value insoluble" is indefinite as to which metal value is referred to, ie. is it one of the metal values.

Also, "to render a metal value insoluble" is indefinite as to what it is rendered insoluble in.

In claim 14, "the digestion mixture" lacks proper antecedent basis in the claim. It is suggested to insert --a digestion mixture comprising-- between "form an" in line 9.

Also, in line 11, it is suggested to insert --a temperature of-- after "attain".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender '490 taken with Pazdej '777.

Bender teaches the process of solubilizing metals from metal containing material by contacting with sulfuric acid containing a reducing agent and a carbon source (see claims 1,29,36 and the examples).

Bender differs in that the sulfuric acid containing hydrofluoric acid is not stated.

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Pazdej teaches the use of sulfuric acid and hydrofluoric acid to solubilize metals (see the figures and claims).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use sulfuric acid containing hydrofluoric acid to dissolve metals in the process of Bender because that is what is taught by Pazdej as desirable.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results, see *In re Aller*, 105 USPQ 233.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, *In re Malagari*, 182 USPQ 549.

Applicant's arguments filed February 26, 1998 have been fully considered but they are not persuasive.

Applicant states that Bender does not utilize a reducing agent and a carbon source.

However the instant claims do not require that the reducing agent and the carbon source be different materials. In other words the reducing agent and the carbon source may be one and the same. Also, claim 36 of Bender teaches the use of a mixture of reductants, ie. reducing

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agents, which includes carbonaceous materials, ie. a carbon source, and another reducing agent, eg. sulfide materials.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

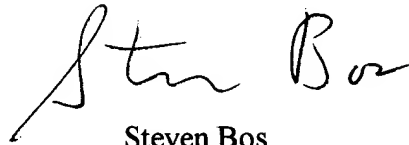
The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1754.

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Any inquiry concerning this communication should be directed to Steven Bos at telephone number (703) 308-2537.

A handwritten signature in black ink, appearing to read "Steven Bos". The signature is written in a cursive, flowing style with a large initial "S" and a distinct "B".

Steven Bos  
Primary Examiner  
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